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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,352	07/18/2003	Joseph F. Bringley	85384PAL	4783

7590 05/26/2006

Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/622,352	BRINGLEY ET AL.	
	Examiner	Art Unit	
	Pamela R. Schwartz	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) 3,4 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5 and 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1, 5 and 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bermel et al. (6,419,355) in view of Moore, Jr. et al. (3,956,171) for reasons of record and for reasons given below.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5 and 7-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-34 of copending Application No. 10/622230. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application disclose an ink jet recording element including core/shell particles with a shell of alumino silicate complex that can be of the instantly claimed formula.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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3. Claims 1, 5 and 7-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 10, 12-21 and 25 of copending Application No. 10/622229. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application disclose an ink jet recording element including core/shell particles with a shell of alumino silicate complex that can be of the instantly claimed formula.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1, 5 and 7-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19, 21 of copending Application No. 10/180179. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application disclose an ink jet recording element including core/shell particles with a shell of alumino silicate complex that can be of the instantly claimed formula.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1, 5 and 7-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19, 21 and 22 of copending Application No. 10/180395. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application disclose an ink jet recording element including core/shell particles with a shell of alumino silicate complex that can be of the instantly claimed formula.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Applicant's arguments filed March 3, 2006 have been fully considered but they are not persuasive. Applicants argue that Bermel does not disclose core/shell particles. Lack of description of the cationic silica particles in Bermel is precisely why one of ordinary skill in the art would have looked elsewhere for teachings of how to form such particles. Applicants also argue that there is no suggestion in Moore et al. to form core/shell particles with polymeric aluminosilicate complex on the surface. The examiner disagrees. The process of Moore et al. appears to result in compounds within the scope of the claimed formula. The examples are directed to reactions, not merely to mixtures of components. Since silica sol is the primary starting material and the title of the patent is "Process for Preparing Stable Positively Charged Alumina Coated Silica Sols and Product Thereof" it appears that a core shell particle is formed with a core of silica and a shell of reaction product as set forth in the examples.

The suggestion to combine the references comes from the necessity when practicing the invention of the primary reference with cationic silica to find a cationic silica for the purpose. The primary reference does not teach how to make cationic silica so it is appropriate to look at the art to determine how to obtain cationic silica for inclusion in the primary reference. Moore et al. is directed to such silica. Therefore, it would have been obvious to one of ordinary skill in the art to use this cationic silica as the cationic silica of the primary reference.

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It is unclear whether applicants are stating that the coating of silica in accordance with Moore et al. will or will not result in a polymeric aluminosilicate complex. This appears to be disclosed by the examples of the reference, but the examiner is not in a position to test the method of Moore et al. to determine with certainty that an aluminosilicate complex is formed. Because the examiner cannot test, but believes there is sufficient evidence of an aluminosilicate complex to allege that one is present, the burden is shifted to applicants to give reasons why such a complex would not be formed by the method of Moore et al. or to provide other evidence that an aluminosilicate complex is not formed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

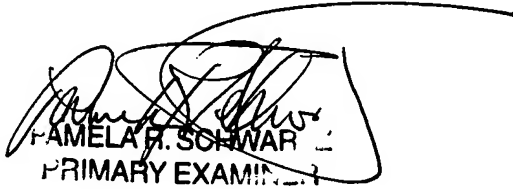
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
May 23, 2006



PAMELA R. SCHWARTZ
PRIMARY EXAMINER